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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,012	10/07/2003	Michael Furst	FURST, M-1	4718
25889	7590	08/04/2008	EXAMINER	
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			SIMONE, CATHERINE A	
			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			08/04/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

<b>Application No.</b> 10/680,012	<b>Applicant(s)</b> FURST, MICHAEL	
<b>Examiner</b> Catherine Simone	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 02 May 2008.
- 2a)  This action is **FINAL**.
- 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 2,7,9,11,14,16-21,24 and 28-32 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 2,7,9,11,14,16-21,24 and 28-32 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \*    c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5)  Notice of Informal Patent Application
- 6)  Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Repeated Rejections***

1. The provisional obviousness-type double patenting rejection of claims 2, 7, 9, 11, 14, 16-21, 24 and 28-32 over claims 1, 4, 8, 17-20 and 22-24 of copending Application No. 10/680,013 is repeated for the reasons previously set forth in last Office Action mailed 10/30/2007, Page 3, Paragraph #5.
2. The 35 U.S.C. 103(a) rejection of claims 2, 7, 9, 11, 14, 16, 18, 20, 21, 24, 28-30 and 32 over Wiercinski et al. in view of Hurst is repeated for the reasons previously set forth in last Office Action mailed 10/30/2007, Pages 4-7, Paragraph #7.
3. The 35 U.S.C. 103(a) rejection of claims 17 and 19 over Wiercinski et al. in view of Hurst and further in view of Zickell et al. is repeated for the reasons previously set forth in last Office Action mailed 10/30/2007, Page 7, Paragraph #8.
4. The 35 U.S.C. 103(a) rejection of claim 31 over Wiercinski et al. in view of Hurst and further in view of Kalkanoglu is repeated for the reasons previously set forth in last Office Action mailed 10/30/2007, Pages 7-8, Paragraph #9.

### ***Response to Arguments***

5. Applicant's arguments filed 5/2/2008 have been fully considered but they are not persuasive.

Applicant argues "the Wiercinski complete film built by films 22 and 22A is always symmetrical. The structure according to the present invention is itself built up by an asymmetric

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construction that is a substantial and important difference over the prior art. Therefore, Wiercinski does not disclose the claimed structure set forth in the claims and does not lead to the present invention even if combined with Hurst, Zickell and Kaklanoglu".

This is not deemed persuasive. It is to be noted that the features upon which applicant relies (i.e., asymmetric construction) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant then argues "Wiercinski does not teach, suggest or disclose anything about the thermal expansion of the various layers in the prior art structure...it is to be pointed out that in claim 32 that a first film layer being located further away from the bituminous layer has a larger coefficient of elongation (coefficient of thermal expansion) than a second film layer. Therefore, the claimed invention is directed to an asymmetric construction. This feature must always be structurally present. Therefore, all layers further away from the bituminous layer must have a greater thermal expansion than a layer located nearer to the bituminous layer."

However, it is to be pointed out that claim 32 does not recite anything about the thermal expansion of the layers in addition to an asymmetric construction. Thus, the features upon which applicant relies (i.e., asymmetric construction and all layers further away from the bituminous layer must have a greater thermal expansion than a layer located nearer to the bituminous layer) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, Applicant argues “the prior art symmetrical construction lead to material failure, while the claimed ‘asymmetrical’ construction did not fail. This unexpected improvement in results for the claimed invention relative to the prior art structure (i.e. –‘asymmetrical’ versus ‘symmetrical’ of Wiercinski) is very strong indicia of the nonobviousness of the claimed invention”.

This is not deemed persuasive. As previously pointed out, claim 32 does not recite anything about an asymmetrical construction. Thus, the feature upon which applicant relies (i.e., asymmetrical construction) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, the tests made and the results shown in Appendix A of Applicant’s response are not commensurate in scope with the claims. Furthermore, it is to be pointed out that the arguments of counsel cannot take the place of evidence in the record. See MPEP 2145 (I) and 716.01(c).

In conclusion, for the reasons given above, the claims of the present application remain unpatentable under 35 U.S.C. 103 over all the prior art references (Wiercinski et al., Hurst, Zickell and Kalkanoglu) applied in the previous Office Action.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571) 272-1501. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Catherine Simone/  
Examiner, Art Unit 1794

/KEITH D. HENDRICKS/

Supervisory Patent Examiner, Art Unit 1794